2-22-07

APP

Express Mail No.: EV 473 971 237 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Application of: Salomon	Confirmation No.: 2900
Application No.: 09/931,425	Group Art Unit: 2143
Filed: August 16, 2001	Examiner: Thanh T. NGUEN
For: INTERNET-DEPLOYED WIRELESS SYSTEM	Attorney Docket No.: 10629-003-999

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Ognjan V. Shentov
JONES DAY
222 East 41st Street
New York, New York 10017-6702
(212) 326-3939
Attorneys for Appellant

TABLE OF CONTENTS

TABLE OF AUTHORITIES

FEDERAL CASES

FEDERAL STATUTES AND REGULATIONS

MISCELLANEOUS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Application of: Salomon	Confirmation No.: 2900
Application No.: 09/931,425	Group Art Unit: 2143
Filed: August 16, 2001	Examiner: Thanh T. NGUEN
For: INTERNET-DEPLOYED WIRELESS SYSTEM	Attorney Docket No.: 10629-003-999

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal under 35 U.S.C. § 134 from a final rejection mailed June 20, 2006 of claims 1-16 of the above-identified application. The Notice of Appeal was filed on December 19, 2006. Appellant submits this original appeal brief accompanied by a Brief on Appeal Fee Transmittal Sheet (in duplicate).

I. REAL PARTY IN INTEREST

WAVELINK Corporation is the assignee of this application and the real party in interest subject to an Intellectual Property Lien granted to CapitolSource Finance LLC. An assignment transferring the right, title, and interest of inventor Kirk C. Salomon to WAVELINK Corporation was submitted for recordation with the U.S. Patent and Trademark Office on August 16, 2001 and recorded on Reel 012105 at Frame 0932. An acknowledgement of Intellectual Property Lien granted to CapitolSource Finance LLC by Wavelink Corporation was recorded on November 1, 2006 at Reel # 018471 at Frame# 0522.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any other pending appeals or interferences relating to the above-identified application.

III. STATUS OF CLAIMS

Claims 1-16 have been finally rejected in the final Office Action mailed June 20, 2006, a rejection maintained by an Advisory Action mailed November 20, 2006. The rejections of claims 1-16 are being appealed.

The application was filed on August 16, 2001 with claims 1-7. Claims 1 and 3-7 were amended and claims 8-9 were added in the Response filed on December 18, 2003 in response to an Office Action mailed on June 19, 2003. A Final Office Action was mailed on March 30, 2004 finally rejecting claims 1-9. A response to the March 30 Final Office Action was filed on June 30, 2004 with amendments to claim 1. An Advisory Office Action, mailed on August 13, 2004, refused to enter the response because of perceived new issues. Based on an interview with Examiner Ingberg on August 26, 2004, a Request to Reconsider the Rejections was filed on August 27, 2004. A Notice of Appeal was filed on September 30, 2004. An Advisory Action, mailed on October 6, 2004 confirmed entry of the amendments to claim 1 filed on June 30, 2004 but maintained the rejections of pending claims 1-9. A Request for Continued Examination was filed on November 30, 2004 adding claims 10-16 and without otherwise amending the claims. A non-final Office Action mailed on February 24, 2005 rejected claims 1-16. Appellant filed a response on June 24, 2005 with amendments to claim 9. A non-final Office Action mailed September 28, 2005 rejected claims 1-16 on different grounds. Appellant filed a response on March 20, 2006 that did not amend the claims. A Final Office Action was mailed on June 20, 2006 with a rejection of claims 1-16. Appellant filed a response to the June 20 Final Office Action on October 19, 2006. An Advisory Office Action maintaining the rejection of claims 1-16 was mailed on November 20, 2006. A Notice of Appeal was filed on December 19, 2006.

A listing of the appealed claims is in Exhibit B (Claims Appendix).

IV. STATUS OF AMENDMENTS

Appellant filed no claim amendments after the June 20 mailing date of the Final Office Action, although a response was filed without amendments to the claims on October 19, 2006.

The following amendments have been entered: Amendment dated December 18, 2003 (amending claims 1, and 3-7 and adding claims 8-9), Response to the March 30 Final Office Action filed on June 30, 2004 (further amending claim 1, entry of which was confirmed in the Advisory Action, mailed on October 6, 2004), Amendment filed November 30, 2004 (adding claims 10-16), Amendment filed June 24, 2005 (amending claim 9), *Amendment* filed March 20, 2006, and Response to the June 20 Final Office Action filed on October 19, 2006.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The pending claims relate to a system for distributing and updating wireless applications on wireless devices connected to a network, which system reduces the resources needed for management and updating of wireless devices connected to the network.

Although individual wireless connections cover short distances, wireless devices to be serviced are distributed over a large geographical area. *See, e.g.*, paragraph 1 of the published application. This typically requires that at least an intermediate server or node in a wired network play the role of an intermediary for communications with a central application server in a higher layer of the wired network. The demands placed on network management are greater in the case of wireless devices than wired devices because of, among other factors, the sensitivity of the wireless connection on the distance covered by the wireless connection, the mobility of wireless devices, the relatively limited bandwidth and the need for short latency available for servicing wireless devices. Further, the plethora of types of wireless devices with widely different capabilities adds to the complexity. These factors are in addition to the need to perform functions such as checking for licenses for deploying applications and, of course, billing.

Prior art central application servers coordinating application deployment to wireless devices, consume inordinate amount of bandwidth for communicating across multiple network layers for customizing applications to be deployed on wireless devices. Application configuring and deployment tasks need real-time attention, placing additional demands on network resources. Complexity of the system becomes a limiting factor with increases in the number of wireless devices being serviced. Partly, the reason is that parameters for application deployment are sent all the way up to the central application server for configuring applications for each device, then the application is sent down to the server actually deploying the applications, and then onto the target wireless device. Frequent retransmissions are required by the relatively fragile wireless links.

Further, this increased system complexity in prior art systems makes it difficult for a person with relatively simple skills to deploy applications on wireless devices.

The pending application discloses a way around these concerns. It describes a system comprising an application server program that is downloaded to one or more remote wireless application server computers, where it executes and causes the one or more remote application server computers to download and to install wireless application software components on the one or more remote wireless application server computer. The wireless application server program installs client applications on mobile devices and locally processes application deployment related data to free the higher network layers from the task of micromanaging application deployment from a distance. The wireless application server program may be configured, for instance, to download and install different wireless applications on different wireless devices. The wireless application server program may pre-process and filter application data before transmitting this data to the central application server in a higher network layer, thereby reducing the bandwidth requirements for application deployment.

Thus, local conditions are taken into account by the downloaded application server program executing on remote application server computers deploying the applications. Should there be a malfunction or difficulty at a particular application server, the problem is likely to be contained as a local problem. Integration of local management with centralized management by way of suitably configuring downloaded application server programs also facilitates better enforcement of license terms and billing operations.

A more detailed description of disclosed embodiments is presented in the specification at paragraphs 16-61 of the published application.

VI. GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review in this appeal:

Whether claims 1-16 are obvious under 35 U.S.C. § 103(a) over US Patent Publication No. 2002/0183056 to Lundblade et al. ("Lundblade Publication") in view of US Patent Publication No. 2002/0057803 to Loos et al. ("Loos Publication").

VII. ARGUMENT

The rejection of claims 1-16 should be reversed on at least three grounds: First, instead of the claims as presented, a paraphrased version has been examined. In effect, the Office Action analysis rejects a different set of claims. Second, the prior art fails to disclose or suggest at least one element of the claimed invention, a downloadable, configurable application server program. Third, the claimed invention has been rejected as being obvious by combining references, the teachings of which conflict with each other. Not surprisingly, the prior art also lacks a teaching, suggestion or motivation to combine the prior art references as assumed by the Office Actions. At the very least, the above grounds are indicative of impermissably exclusive reliance on hindsight, contrary to applicable case law and Patent Office guidelines.

The three disclosures in question here, the Loos Publication, the Lundblade Publication and the above-captioned application address three different concerns about downloading applications to mobile devices. Their respective solutions and the underlying concerns are quite different and resist being combined, as they provide three different approaches to the problem of efficient application distribution to wireless mobile devices.

A. Applicable Case Law, Regulations and Guidelines

A finding of obviousness under 35 U.S.C. §103 requires a determination of: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the difference between the claimed subject matter and the prior art; and (4) whether the differences are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. Deere* 383 U.S. 1 (1966). Whether the differences make the subject matter obvious to one of ordinary skill in the art at the time the invention was made is evaluated with the aid of many factors while guarding against decision making improperly based on hindsight. *Id.* at 36.

The Federal Circuit has articulated a subsidiary requirement for the first Graham factor, the scope and content of the prior art. *SIBIA Neurosciences, Inc. v. Cadus Pharma. Corp.*, 225 F.3d 1349, 1356 (Fed. Cir. 2000). The scope and content of prior art is evaluated to determine if it directly or indirectly contains a teaching, suggestion, or motivation to combine multiple references in a manner that renders the invention obvious. The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

As to the scope and content of the prior art, patentable apparatus claims must be structurally distinguishable from the prior art. *See, e.g.*, MPEP § 2114. Further, even if the claimed subject matter is not literally disclosed by a reference, it may be inherent. *See, e.g.*, MPEP § 2112. Something that is old does not become patentable upon the discovery of a new property. *See, e.g.*, MPEP § 2112 (I). However, the Examiner must show rationale or evidence tending to show inherency. *Id.*

The difference between the claimed subject matter and the prior art requires claim interpretation. *See, e.g.*, MPEP § 2141.02 directing to MPEP §§ 2111-2116. The Patent Office is to give claims their broadest reasonable interpretation. *See, e.g.*, MPEP § 2111 citing to recognition of this practice by the Federal Circuit in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1310 (Fed. Cir. 2005 *en banc*). Words in the claims must be given their plain meaning unless defined otherwise in the specification. *See, e.g.*, MPEP § 2111.01. 'Plain Meaning' refers to the ordinary and customary meaning given to the terms by those of ordinary skill in the art. *See, e.g.*, MPEP § 2111.01 (III).

The burden shifts to the applicant once a reference teaching a product appearing to be substantially identical (to the claimed invention) is made the basis of a rejection coupled with evidence or reasoning tending to show the substantial identity.

Many factors may be considered to evaluate if the invention is not obvious in view of the differences between the prior art and the claimed invention. A known but unsolved problem or solutions that teach away from the invention are examples of factors that tend to show the invention is not obvious. In evaluating the differences between the prior art and the claimed invention, the relevant inquiry is: (1) whether the prior art suggests the invention; and (2) whether the prior art provides one of ordinary skill in the art with a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

When selective combination of prior art references is required to render obvious a subsequent invention, "there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F2d. 931, 934 (Fed. Cir. 1990) "[T]here must be some reason for the combination other than the hindsight gleaned from the invention itself. There must be 'something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). This inquiry is part of identifying the scope and content of the prior art. The Federal Circuit has repeatedly clarified that the test is a flexible one which may find motivation to combine in the knowledge of one skilled in the art or in the nature of the problem to be solved. *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291 (Fed. Cir. 2006).

The case law has been especially vigorous on guarding against using "hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." See, *e.g.*, *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The Federal Circuit said in *In re Dembiczak*

> Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. ... Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

In re Dembiczak, 175 F.3d 999 (emphasis added). With respect to what might meet the requirement of a showing of motivation, the Federal Circuit said that

> To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, *the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.*

In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added). The Examiner must "explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added). With respect to the sources where motivation to combine may be found, the Federal Circuit stated that "[t]his court has identified three possible sources for a motivation to combine references: the nature of the

problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

The case law further requires that each reference must be evaluated as a whole, *i.e.*, disclosures in the reference that diverge from and teach away from the invention cannot be disregarded. "Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). "It is *impermissible* within the framework of a Section 103 rejection *to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what the reference fairly suggests* to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241 (C.C.P.A. 1965) (emphasis added).

B. The Rejection Under 35 U.S.C. § 103(a) Of Claims 1-16 Should Be Reversed Because The Rejection, Without A Basis, Treats The Differences Between A Downloadable Application Server Program And An Application Deployment Server As Inconsequential

Claims 1-16 have been rejected under 35 U.S.C. § 103(a) by the Final Office Action mailed on June 20, 2006 and the Advisory Action mailed on November 20, 2006. These Office Actions have rejected the three independent claims 1, 8 and 9 in a conclusory fashion. Specifically, the November 20 Advisory Action, on page 2, contends that the Lundblade Publication discloses, using different language, the same matter as in the rejected claims. The underlying June 20 Final Office Action provides similar conclusory grounds for rejecting all of the claims.

The rejection of claims 1-16 should be reversed because the scope and content of the prior art lacks a downloadable, configurable application server program, notwithstanding which the claims have been rejected by combining references that conflict with each other. Not surprisingly, the prior art also lacks a teaching, suggestion or motivation to combine the references, which combination is, therefore, provided in the Office Action by impermissable exclusive reliance on hindsight.

1. The Lundblade Publication

The Lundblade Publication provides safe and secure application distribution and execution by providing systems and methods that first test an application to ensure that it satisfies predetermined criteria associated with the environment in which it will subsequently

execute. *See, e.g.*, the abstract of the Lundblade Publication. It is primarily concerned with security issues. *Id.* at paragraphs 7-8 of the Lundblade Publication. The Lundblade Publication does not disclose or suggest any configuration of an Application Download Server (ADS) or configuration of applications being deployed by the ADS.

Using rules and permission lists, application removal, and a modification detection technique, such as digital signatures, the Lundblade Publication discloses mechanisms to safely distribute and execute tested, or untested, applications by determining whether the application has been modified, determining if it has permission to execute in a given wireless device environment, and removing the application should it be desirable to do so. *Id.* The Lundblade Publication describes the ADS, which in response to a request, can send (i) permission lists, (ii) developer identification, and (iii) digital signatures to a wireless device. Paragraph 43 further discloses that the ADS provides connectivity to multiple networks for distribution of (i) applications, (ii) files, and (iii) other information to wireless devices. Further, an applications permission list and developer identification may be transmitted to a wireless device via the ADS, again, without any disclosure of configuration by the ADS of applications being deployed.

2. <u>The Loos Publication</u>

The Loos Publication discloses the use of a program executing on the wireless client to coordinate application downloading in face of the fickle wireless connections. This strategy overcomes the difficulties posed by fickle wireless connections and their less than desirable interaction with wired networks that expect 'persistent network connections.' The Loos Publication describes an application program executing on the mobile device to manage and install applications on the device based on the user identity. *See, e.g.*, paragraph 65 of the Loos Publication. To this end, the Loos Publication describes a 'colonist' program, which when executed by the user requests user identity information from the user, and then connects to a sever to authenticate the user. *See, e.g.*, paragraph 66 of the Loos Publication. Following satisfactory authentication, the colonist establishes "full connectivity" with the "server-based mobile computing system." *Id.*

The Loos Publication also clarifies that prior art, i.e., based on "persistent network connections" provide a "sub-optimal solution for extending an enterprise network to mobile devices. *See, e.g.*, paragraph 4 of the Loos publication. Accordingly, the Loos Publication makes a distinction between the local applications and the "server-based mobile computing system." *See, e.g.*, paragraphs 65-66 of the Loos Publication.

3. Rejections of Independent Claims 1, 8 and 9

Exemplary claim 1, in part, may be parsed as requiring: (a) central application server program, (b) configured to (i) be downloaded to one or more remote wireless application server computers, and (ii) to execute on the one or more remote wireless application server computers. As demonstrated next, at least (a), (b)(i) and (b)(ii) are not disclosed by either the Lundblade Publication or the Loos Publication. In addition to paraphrasing claim 1, claims 1, 8 and 9 have not been distinguished between by the relevant Office Actions. As a result, the same grounds have been applied to reject all of them together as a group.

The independent claims are patentable at least because the difference between the prior art and the claimed invention would not have been obvious to one having ordinary skill in the art in view of the record.

a. The scope and content of the prior art

The scope or content of the prior art comprises (**1**) overcoming the fickle wireless connections and their less than desirable interaction with wired networks that expect 'persistent network connections' as disclosed by the Loos Publication; and (**2**) testing an application prior to its detailed configuration by a central server in the wired network to ensure it is suitable for its environment in view of the diversity of mobile devices connected to a wired network, as disclosed by the Lundblade Publication.

The prior art does not include (**3**) a teaching, suggestion or motivation to combine the Loos Publication with the Lundblade Publication. As taught in the relevant case law, *see, e.g.*, *SIBIA Neurosciences* at 1356, the prior art should include a basis for combining the references, for instance in the form of a teaching, suggestion or motivation to make the combination. In this case, combining the Loos Publication with the Lundblade Publication would defeat the central argument of the Loos Publication that traditional prior art servers rely on 'persistent network connections' to their detriment, a defect it cures by using a wireless client resident program to manage application downloading.

The prior art also does not include (**4**) any teaching of a downloadable, configurable application server program.

b. Difference between the prior art and the claimed invention

The record reveals that the difference between the prior art and the claimed invention includes at least a downloadable configurable application server program.

The Advisory Action confirms the concession that the Lundblade Publication does not disclose the limitations of claims 1, 8 and 9 including a downloadable configurable

application server program. *See*, last sentence on extension page of PTOL 303 mailed November 20, 2006. However, the Advisory Office Action makes light of the these shortcomings noting that the Lundblade Publication uses "different language but the Lundblade Publication discloses the same function as application claimed [sic] function." *Id.* at last sentence on extension page of PTOL 303.

This assertion is not backed by evidence. The absence of underlying reasons and the lack of express claim interpretation indicates that they have not been given the broadest possible reasonable scope. There is no rationale or evidence showing inherency as may be required by MPEP § 2112 (I). The words in the claims have yet to be interpreted in accordance with MPEP § 2112 (I) to shed light on any unusually broad meaning being assigned to the pending claims. While reliance on hindsight is freely admitted by the Office Actions and Advisory Actions, *id.* first paragraph on extension page of PTOL 303 noting "any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, it is not clear whether and how this reliance is limited to comply with guidance provided by the case law, *e.g.*, the admonishment against improper exclusive reliance on hindsight. Similarly unclear is the teaching, suggestion or motivation, *e.g.*, required by *In re Dembiczak*, to make the combination of Loos and Lundblade in view of their incompatible teachings, a possible guard against improper reliance on hindsight.

What is clear is that the Central Application Server of the Lundblade Publication is like the prior art application server discussed in the background of the above-captioned application. The Application Deployment server of the Lundblade Publication is not even suggested to be configurable for deployment. Further, the Application Deployment Server is akin to a dumb terminal in that it merely passes on paramerters received from the Central Application Server. Therefore, the Lundblade Publication does not disclose the limitations of claims 1, 8 and 9 including a downloadable configurable application server program.

c. Level of skill in the art

The standard of a person having ordinary skill in the art is satisfied by a person knowledgeable about wireless networks, who takes into account the teachings provided by experts and relevant standard bodies, rather than ignore their teachings and suggestions.

The three patent applications date from the same time period with their filing dates separated by just a few months. The Loos Publication is based on an application filed on May 3, 2001. The Lundblade Publication is based on an application filed on May 31, 2001 while the above-captioned application was filed on August 16, 2001.

d. Reasoning and evidence offered to support the Rejections

The reasoning for the rejections includes the three part argument that: (**1**) hindsight is a necessary component of making an obviousness based rejection (without explaining how did the rejection limits itself to knowledge within the level of ordinary skill in the art at the time the invention was made); and (**2**) that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention; and (**3**) the conclusory assertion that the claim limitations are disclosed in the references, as asserted.

e. The problems addressed by the cited references

The Loos Publication deals with the fickle wireless connections, while the Lundblade Publication is directed to testing an application prior to its deployment.

The Loos Publication describes the problem posed by fickle wireless connections succinctly in paragraph 4 as "[c]onventional options, such as wireless web-based connectivity, data synchronization technology, and in-house developed solutions, have substantial disadvantages." It, then, describes the disadvantages as "The wireless web model is highly connection-dependent. To work effectively, the connection between the thin-client and the network server should remain in place the entire time an application is in use by the mobile device." *Id.* Because it is "very difficult for mobile clients to remain connected or to guarantee connectivity for extended amounts of time." *Id.* Thus, the highly connection-dependent web model based on persistent connections conflicts with what is typically possible with the relatively unreliable wireless connections.

The Lundblade Publication discloses sending a set of permissions to the wireless device via a server so that the wireless device decides whether to allow the application downloaded to it to be installed. *See, e.g.*, paragraph 79 of the Lundblade Publication. The Lundblade Publication further clarifies the nature of its Application Download Server ("ADS") as being distinct from the downloaded server program recited in the pending claims. The Lundblade Publication's ADS is "used to interface with a wireless device" and the central server may also "send the permissions list and developer identification associated with the application" to the wireless device. *See, e.g.*, paragraph 42 of the Lundblade Publication. ADS merely stores such information. *Id.*

f. Lack of a reasonable likelihood of success for the combined references

Combining the Loos Publication with the Lundblade Publication would defeat the central argument of the Loos Publication that traditional prior art servers rely on 'persistent

network connections' to their detriment. Therefore, one of ordinary skill in the art would not be directed to combine the Loos Publication with the Lundblade Publication in view of this teaching away from the rejected claimed subject matter.

g. The difference of the claimed subject matter from the prior art is not obvious because it is not an insignificant detail

The rejections are premised on the erroneous conclusory presumption that the claims are obvious, rather than an actual demonstration of obviousness. This presumption is not a sufficient basis because it does not satisfy the requirement of (1) the all elements rule requiring that all elements of a claim be found in the prior art, and (2) the guard against improper reliance on hindsight requiring showing of a teaching, suggestion, or motivation to make the combination.

Presuming the result, as in the proceedings below, subverts the requirement for presenting an argument, evidence or reasons for arriving at the result by deductive reasoning. Thus, although neither the ADS nor the Central Application Server of the Lundblade Publication are disclosed to be downloadable (or configurable) as claimed, the rejections have presumed this and other claimed features. This approach undermines the requirement to make a prima facie case for rejecting a claim.

For instance, the Loos Publication discloses a program downloaded to the mobile device to manage application downloading in preference to using a server in the wired network to manage application downloading, while the Lundblade Publication discloses a traditional prior art central server. As described in the Summary of the Claimed Subject Matter above, the fickleness of wireless connections combined with the sheer diversity of mobile device types and the bandwidth requirements poses a significant network management problem. The Loos Publication discloses one approach to tackle the fickle wireless connections, while the Lundblade Publication is directed to testing an application prior to its deployment in a relatively unpredictable environment. Neither deals with downloading a configurable application server program to a remote computer in a wired network to manage downloading applications to mobile wireless devices. Therefore, even if combined, they fail to disclose at least one limitation of the rejected claims.

Appellant pointed out in the proceedings below that there is no basis for the insistence that the Application Deployment Server of the Lundblade Publication meets the limitation of a downloadable configurable application server program described in the rejected claims.

Downloading of a server program to execute and manage application downloading to wireless mobile devices is not an insignificant detail. It is not disclosed or suggested by the

prior art. And, it allows the upper layer to configure the application server program with fewer parameters while needing less bandwidth and providing greater flexibility. This is significant in wireless networks because wireless devices operate over short distances, have fickle connections, and vary tremendously in their capabilities, which translates into a need for better local control.

A central application server fine-tunes a few settings on a downloadable application program server program to match local needs. This reduces bandwidth requirements as fewer application programs and parameters need to be sent to or received all the way to the central application server. It also provides a different solution to the lack of persistent wireless connections by providing local management that does not waste resources by engaging the entire network due to failures in the wireless links, which risk of failures also demands real time responses from the wired network.

The Lundblade Publication plainly fails to achieve this objective. Instead, it describes a typical prior art central server that makes most if not all decisions for application deployment and carries out much of the processing for deploying an application on a wireless device, *see, e.g*, paragraphs 39-41 of the Lundblade Publication, while pre-evaluating an application for deployment on a specific wireless device. The Lundblade Publication discloses a strategy to deal with the diversity of mobile devices that may connect to a wired network. The otherwise conventional central server of the Lundblade Publication sends the application and associated parameters to an Application Deployment Server for subsequent deployment to a wireless device. *Id.* paragraph 42.

Indeed, the problem solved by the present invention is not addressed or solved by the Lundblade Publication. Not surprisingly, the Lundblade Publication also does not teach, disclose or suggest local processing by the Application Deployment Server for configuring an application to increase the efficiency and stability of application deployment to wireless devices.

Although all independent claims have been rejected on the same grounds, Appellant address the independent claims individually for completeness. Independent claim 8 describes a server system in which at least one application server program and at least one wireless software program are downloaded (from a central site application server) to a remote application server, and a wireless device is able to exchange data with the remote application server and the central site application server. As in the case of claim 1, the application server program is downloaded to the remote server and executes on it for deploying the application on a wireless device.

Independent claim 9 covers a server system in which a remote site application server has a remote site application component configured by the central site application server to communicate both with an access point (over a local area network) and the central site application server. Such a remote site application component configured by the central site application server is not disclosed by the cited art.

Therefore, the proceedings below ignore both the problem addressed by this application and its claimed solution. Instead, the Final Rejection and the Advisory Action insist on examining language, introduced by way of paraphrasing the presented claims. This replaces the presented claims with alternative language for convenience in making and maintaining the rejections, but without the rigor of claim interpretation. Indeed, there is no reason for a person having ordinary skill in the art to ignore the disclosure of the Lundblade Publication or the Loos Publication and instead deploy the solution outlined in the rejected claims –all the while insisting that such an approach completely relies on the Lundblade Publication and the Loos Publication. But, this is the argument relied upon in the proceedings below to reject all of the claims.

What is missing in the rejections is any discussion that is not based on the Appellant's own disclosure. Further, although case law requires that each reference be evaluated as a whole for what it discloses, *see*, *e.g.*, *Interconnect Planning*, the cursory conclusory rejections also ignore this guideline.

In view of the above, it is plain that one of ordinary skill in the art would not interpret the fixed application server of the Lundblade Publication to be a downloadable server program, much less a server program that is configured and downloaded to be executed at another computer. No such scenario is discussed or contemplated by the Lundblade Publication.

In summary, the claimed invention is not obvious because first, the prior art does not disclose all of the limitations of the claimed invention including at least the limitation of a downloadable configurable application server program that then executes and carries out the application deployment on wireless devices; second, the suggested combination of references necessarily undermines one the combined references' central teaching; and third, the prior art fails to provide a teaching, suggestion or motivation, based on the nature of the problem or knowledge of one having ordinary skill in the art, to combine the cited references in the manner suggested by the rejections.

4. Dependent Claims

The arguments for the patentability of the independent claims 1 and 9 axiomatically establish the patentability of all claims dependent upon them.

Dependent claim 6, which is ultimately dependent on independent claim 1, provides for processing and filtering of application data before it is sent to the upper layer central site application server. This filtering feature, as pointed out earlier, operates to reduce the bandwidth consumption over that required by the cited prior art.

Other features possible with the application deployment in accordance with the independent claims are described in dependent claims 10-16. Taken together, these features further establish patentability of the claimed invention.

VIII. CLAIMS APPENDIX

As noted in Section III above, an appendix containing a copy of the claims involved in this appeal is submitted herewith as Exhibit B.

IX. EVIDENCE APPENDIX

Appellant is not aware of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132.

US Patent Publication No. 2002/0183056 naming Lundblade et al. as the inventors and US Patent Publication No. 2002/0057803 naming Loos et al. as the inventors were cited by the Examiner in the Office Action mailed on February 24, 2005.

X. RELATED PROCEEDINGS APPENDIX

As noted in Section II above, Appellant is not aware of any proceeding or interference which may be related to, directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

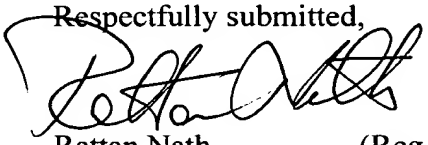
XI. CONCLUSION

Appellant respectfully submits that the rejection of claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over the Lundblade Publication in view of the Loos Publication is improper and should be withdrawn. Further, claims 1-16 are allowable in view of the record.

Therefore, for all of the reasons set forth above, Appellant respectfully requests that all of the claims on appeal be declared allowable. The filing of the Brief on Appeal is timely today because the Patent Office was closed for business on February 19, 2007.

A fee of $250 is estimated to be due with this filing of the Appeal on Brief under 37 C.F.R. 40.20(b)(2). Please charge the fee for filing Appeal on Brief to Jones Day Deposit Account No. 50-3013. A copy of this page is enclosed for fee payment purpose. Please charge any additional required fees to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,



Date: February 20, 2007

Rattan Nath (Reg. No. 43,827)
For
Ognjan V. Shentov (Reg. No. 38,051)
JONES DAY
222 East 41st Street
New York, New York 10017-6702
(212) 326-3939

EXHIBIT A
REAL PARTY IN INTEREST

U.S. APPLICATION NO. 09/931,425
ATTORNEY DOCKET NO. 10629-0003-999

I. Assignment from Kirk C. Salmon to Wavelink Corporation executed on August 14, 2001 recorded on August 16, 2001 at Reel # 012105 at Frame# 0932.

II. Acknowledgement of Intellectual Property Lien granted to CapitolSource Finance LLC by Wavelink Corporation executed on October 5, 2006 recorded on November 1, 2006 at Reel # 018471 at Frame# 0522.

EXHIBIT B
CLAIMS APPENDIX

CLAIMS ON APPEAL
U.S. APPLICATION NO. 10/278,587
ATTORNEY DOCKET NO. 002988-0704-999

1. (Previously presented) A wireless application server system comprising digital data stored on one or more storage media, the data further comprising:

a central application server program configured to be downloaded to one or more remote wireless application server computers and to execute on the one or more remote wireless application server computers, the central application server program being further configured to cause the one or more remote wireless application server computers to download and to install one or more wireless application software components on the one or more remote wireless application server computer;

one or more remote wireless application server programs being configured to transmit to one or more portable devices one or more client applications and to cause the one or more portable devices to install the one or more client applications;

the one or more client applications being configured to communicate with the remote wireless application server computer over a wireless network.

2. (Original) The wireless application server system of claim 1, further comprising a license server configured to update a database of license information in response to execution of the wireless application software and to cause notifications of charges to be generated based on the license information.

3. (Previously presented) The wireless application server system of claim 1, further comprising a central application server configured to transmit the application server program and the one or more wireless application software to the one or more remote wireless application server computers.

4. (Previously presented) The wireless application server system of claim 1, wherein the application server program is further configured to download and to install a different set of wireless application server components on different remote wireless application server computers.

5. (Previously presented) The wireless application server system of claim 1, wherein the data further comprises application data resulting from execution of the one or more wireless application server programs.

6. (Previously presented) The wireless application server system of claim 5, wherein the application data is processed and filtered by the one or more local application server computers before transmitting the pre-processed and filtered data to the master application server.

7. (Previously presented) The wireless application server system of claim 1, wherein the application server program is further configured to cause the one or more local application server computers to update one or more wireless application software programs on the one or more remote wireless application server computers.

8. (Original) A wireless application server system comprising:

an application server database comprising at least one application server program;

a wireless software database comprising at least one wireless software program; and a central site application server, the central site application server comprising a computer and a storage media for storing programs and data, the computer located at a central site and in communication with a communication network, the computer executing a server program configured to download the at least one application server program and the at least one wireless software program to a remote application server in response to a request by the remote application server;

wherein a wireless device executing one of the at least one wireless software program downloaded from the remote application server exchanges data with the remote application server and the central site application server.

9. (Previously presented) A wireless application server system comprising:

a central site application server in communication with a communication network;

a remote site application component configured by the central site application server to execute on a remote site application server, the remote site application component configured to communicate with the central site application server and to communicate with an access point over a local area network; and

a wireless client component configured to execute on a wireless device in communication with the access point, the wireless client software configured to provide exchange of application data with the central site application server and the remote site application server.

10. (Original) A wireless application server system according to claim 1, wherein the central application server program has a component that provides at least one member of the group consisting of seamless roaming across network subnets, session persistence through out of range conditions, session persistence through suspend/resume, compression for low bandwidth conditions, encryption capability, user authentication, and roamable virtual private network functionality.

11. (Original) A wireless application server system according to claim 9, wherein the remote site application component has a sub-component that provides at least one member of the group consisting of product deployment capability, product licensing capability, product support capability, data services and management, enterprise integration, user management and profiles, administrative capabilities, and core security layers including encryption and authentication.

12. (Original) A wireless application server system according to claim 9, wherein the remote site application component has a sub-component that provides at least one member of the group consisting of over the air device software and configuration upgrades of business applications, support for remote site wireless devices from a central location, support for a heterogeneous installed base of wireless devices, hardware and software configuration capture, monitoring and management of wireless devices from the central site, data synchronization capabilities to mobilize enterprise applications, file backup from mobile and wireless devices to secure servers, initiation of remote action on servers by mobile devices and other client/server interaction, open standard XML data transport protocol, seamless roaming across network subnets, session persistence through out of range conditions, session persistence through suspend/resume (battery management), compression for low bandwidth conditions, and security, including encryption, user authentication, roamable virtual private network functionality, real time status monitoring, connection activity logging, and event logging for troubleshooting.

13. (Original) A wireless application server system according to claim 9, wherein the remote site application component has a sub-component that provides at least one member of the group consisting of seamless roaming across network subnets, session persistence through out of range conditions, session persistence through suspend/resume, compression for low bandwidth conditions, encryption capability, user authentication, and roamable virtual private network functionality.

14. (Original) A wireless application server system according to claim 9, wherein the remote site application component has a sub-component that provides support for at least one member of the group consisting of auto discovery and profiles for access points, remote and secure wireless network administration, remote configuration and monitoring of access points, wireless LAN security, wireless LAN monitoring, and diagnostics and alert notifications by E Mail or Web.

15. (Original) A wireless application server system according to claim 8, wherein the at least one server program has a component that provides at least one member of the group consisting of seamless roaming across network subnets, session persistence through out of range conditions, session persistence through suspend/resume, compression for low bandwidth conditions, encryption capability, user authentication, and roamable virtual private network functionality.

16. (Original) A wireless application server system according to claim 1, wherein a remote wireless application server program has a component that provides at least one member of the group consisting of seamless roaming across network subnets, session persistence through out of range conditions, session persistence through suspend/resume, compression for low bandwidth conditions, encryption capability, user authentication, and roamable virtual private network functionality.

Therefore, for all of the reasons set forth above, Appellant respectfully requests that all of the claims on appeal be declared allowable. The filing of the Brief on Appeal is timely today because the Patent Office was closed for business on February 19, 2007.

A fee of $250 is estimated to be due with this filing of the Appeal on Brief under 37 C.F.R. 40.20(b)(2). Please charge the fee for filing Appeal on Brief to Jones Day Deposit Account No. 50-3013. A copy of this page is enclosed for fee payment purpose. Please charge any additional required fees to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Date: February 20, 2007

Rattan Nath (Reg. No. 43,827)
For
Ognjan V. Shentov (Reg. No. 38,051)
JONES DAY
222 East 41st Street
New York, New York 10017-6702
(212) 326-3939